

REMARKS

Claims 1-64 are currently pending in this application, with Claim 1 being in independent format. Independent Claim 1 has been amended to include the limitations of Claim 37. Claims 2-4, 6-13, 18, and 42-64 have been withdrawn. Claims 19 and 37 have been canceled. Claims 1, 5, 14-17, and 19-37, and 39-41 stand rejected. Applicants appreciate the statement by the Examiner that Claim 38 is allowable.

In the Office Action mailed May 26th, 2009, the Examiner rejected Claims 1, 5, 14-17, 19-37, and 39-41 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,668,273 to Allen et al. (hereinafter, the Allen patent). Claims 1, 5, 14-17, 20-36, and 39-41, as amended, are patentable over Allen in setting out a carboxy(C₁-C₃)alkylcellulose ester having:

a degree of substitution per anhydroglucose unit of hydroxyl of from 0.10 to about 0.90.

a degree of substitution per anhydroglucose unit of butyryl of from 1.10 to 2.55, and

a degree of substitution per anhydroglucose unit of acetyl of from 0.10 to about 0.90; and

an inherent viscosity of 0.05 to 0.13 dL/g, as measured in a 60/40 (wt./wt.) solution of phenol/tetrachloroethane at 25 °C.

In rejecting claims under 35 U.S.C. § 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In doing so, the Examiner must make the factual determinations set forth in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). The Examiner has the initial burden of presenting a *prima facie* case of unpatentability, whether based on prior art or any other ground. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "If the PTO fails to meet this burden, then the applicant is entitled to the patent." *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002). Only if the Examiner satisfies the initial burden of establishing a proper *prima facie* case of obviousness does

any burden then shift to the applicant to overcome such a properly formed *prima facie* case with argument and/or evidence. See *In re Kumar*, 418 F.3d 1361, 1366 (Fed. Cir. 2005).

In meeting this initial burden, the Examiner “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d at 1075. Similarly, it “is impermissible ... to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965). Thus, as the Federal Circuit has consistently held, “[t]he mere fact that the prior art *may be modified* in the manner suggested by the Examiner does not make the modification obvious unless the prior art *suggests the desirability* of the modification.” *In re Fritch*, 972, F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added); see also *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). This desirability of making the claimed combination must be found in the prior art, not in the applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 490 (Fed. Cir. 1991).

Finally, as the United States Supreme Court has recently reiterated, the analysis of the interrelated teachings of the prior art references used in a rejection “should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). To this end, the Federal Circuit has made clear that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning* with some *rational underpinning* to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added) (cited with approval in *KSR Int’l Co.*, 550 U.S. 398). In the present case, these requirements of a *prima facie* case of obviousness simply have not been satisfied.

In addition, the Board of Patent Appeals and Interferences has recently confirmed that an obviousness rejection under 35 U.S.C. § 103 still requires that the prior art teach or at least suggest each and every feature of the claimed invention. See *In re Wada and Murphy*, Appeal 2007-3733, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

In the present case, these requirements of a *prima facie* case of obviousness simply have not been satisfied for the claims as amended since Allen does not teach the claimed cellulose mixed ester having the specifically recited values of total degree of substitution, degree of substitution of hydroxyl, butyryl, acetyl, and the inherent viscosity range. Therefore, if the Examiner intends to maintain the rejection over Allen, the Examiner must provide an “articulated reason” supported by “rational underpinning” adequate to establish a proper *prima facie* case of obviousness. Thus, Applicants submit that no *prima facie* case of obviousness has been established for the amended claims and respectfully request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

In the Office Action, the Examiner further rejects Claims 1, 5, 14-17, 19-37, and 39-41 under 35 U.S.C. § 103(a) as being obvious over PCT Published Application No. WO 01/35719 to Obie (hereinafter, Obie).

Claims 1, 5, 14-17, 20-36, and 39-41, as amended, are patentable over Obie in setting out a carboxy(C₁-C₃)alkylcellulose ester having:

a degree of substitution per anhydroglucose unit of hydroxyl of from 0.10 to about 0.90,

a degree of substitution per anhydroglucose unit of butyryl of from 1.10 to 2.55, and

a degree of substitution per anhydroglucose unit of acetyl of from 0.10 to about 0.90; and

an inherent viscosity of 0.05 to 0.13 dL/g, as measured in a 60/40 (wt./wt.) solution of phenol/tetrachloroethane at 25 °C.

According to the foregoing, Applicants submit that amended independent claim 1 is in condition for allowance since Obie does not teach the claimed cellulose mixed ester having the specifically recited values of total degree of substitution, degree of substitution of hydroxyl, butyryl, acetyl, and the inherent viscosity range. Additionally, while claims 5, 14-17, and 20-36, and 39-41, which depend from independent claim 1, each recites additional patentable features, these claims should also be in condition for

allowance because they depend from a patentable independent claim (MPEP § 2143.03).

A terminal disclaimer has been filed with this response over copending Application No. 10/796,176. It is requested that the provisional rejection on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Docket: 71626US03

In light of the foregoing, Applicants submit that claims 1, 5, 14-17, and 20-36, and 38-41 are in condition for allowance.

Respectfully submitted,

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